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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,822	12/28/2000	Michael Wayne Nelson	CSCS-3804	8487

7590 08/23/2005
WAGNER, MURABITO & HAO LLP
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EXAMINER

VAUGHN, GREGORY J

ART UNIT PAPER NUMBER

2178

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,822

Applicant(s)

NELSON ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the Request for Continued Examination, filed on 5/12/2005.
2. Applicant has amended claims 1, 10, 19 and 28.
3. Claims 1-36 are pending in the case, claims 1, 10, 19 and 28 are independent claims.
4. A request for continued examination filed under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 1/12/2005) has been withdrawn pursuant to 37 CFR 1.114.
5. Examiner's rejections of claims 1-36, made under 35 USC 102, as being anticipated by Spencer US Patent 6,356,909 as recited in the previous office action (dated 1/12/2005) are withdrawn in view of the amended claims and applicant's remarks. New grounds of rejection are described below.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

7. Claims 1-9 and 28-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. **Regarding Claims 1-9**, the claimed invention is so abstract and sweeping as to cover the method if practiced by a human operator assisted only by pencil and paper. Claims 1-9 do not include a particular machine or apparatus, and no machine-implemented steps are recited. Every step is capable of performance by the human mind. A method of this sort, traditionally called a "mental process", is not patentable subject matter.

"Phenomena of nature, though just discovered, *"mental processes"*, abstract intellectual concepts are not patentable as they are the basic tools of scientific and technological work." (Emphasis added). *Gottschalk v. Benson*, 175 U.S.P.Q. 673, 675 (U.S.S.C. 1972). See also, *In re Prater and Wei*, 159 U.S.P.Q. 583 (1968), *rehearing*, 162 U.S.P.Q. 571 (1969).

9. **Regarding Claims 28-36**, the system claimed in claims 28-36 are not embodied on a computer readable medium. Systems not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760

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(claim to a data structure per se held nonstatutory). See MPEP § 2106

(IV.1.a)

Furthermore, the system claimed in claims 28-36 are a non-descriptive data structure. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. See MPEP § 2106 (IV.1.b).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

11. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer US Patent 6,356,909 (filed 8/23/1999, patented 3/12/2002) in view of Gurne et al. US Patent 5,541,840 (filed 6/25/1993, patented 7/31/1996, hereinafter "Gurne").

12. **Regarding independent claim 1**, Spencer recites: *"Using templates for predetermined RFP types (step 23), RFP creators can quickly choose a template that enables them to begin creating a client specific RFP. After the template or an existing RFP is selected, the user may review the RFP to add or delete appropriate sections or questions, as shown in step 24"* (column 12, lines 34-38). Spencer further recites: *"In one embodiment of the present invention, the system and method provide RFP creators with the capability to capitalize on previously developed RFP's and specific questions within each RFP using a question database and a RFP database accessible through the web site interface"* (column 3, lines 26-31). Spencer further discloses

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selecting the sequence of sections in Figure 4 at reference sign 28, shown as *"Organize RFP"*.

Spencer discloses a user selecting a template from a plurality of templates as described above. Spencer fails to explicitly disclose selecting from a list. Gurne teaches the selection of a template from a template list. Gurne recites: "To retrieve a predetermined template, the technician simply selects that template from the selection list" (column 10, lines 35-36). Therefore it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the customizable template of Spencer with the template list selection as taught by Gurne, to provide *"the capability for the technician to develop customized reading templates for gathering such diverse information quickly and efficiently"* (Gurne, column 10, lines 26-28).

13. **Regarding dependent claims 2-6**, Spencer discloses a database used to store content in Figure 3A at reference signs 2-7, shown as *"Question Database"*, *"Analysis Database"*, *"Response Database"*, *"Client Database"*, *"User Database"* and *"RFP Database"*. Spencer further discloses in Figure 3C, at reference signs A, B and C; lists of content that is selectable subject matter.
14. **Regarding dependent claims 7**, Spencer discloses in Figure 4 creating a new template at reference sign 21 (shown as *"Create Brand New RFP"*).
15. **Regarding dependent claims 8**, Spencer recites: *"This allows users to prepare reports at any time during the process. Any additional information*

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that may be needed is generated. This allows users to output all of the data into the format of their choice or use the internal system tools to generate reports/results" (column 16, lines 47-49).

16. **Regarding dependent claim 9**, the claim is directed toward substantially the same subject matter as claim 2, and is rejected with the same rationale.
17. **Regarding claims 10-18 and 28-36**, the claims are directed toward a system for the method of claims 1-9, and are rejected with the same rationale.
18. **Regarding claims 19-27**, the claims are directed toward a computer readable medium for the method of claims 1-9, and are rejected with the same rationale.

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Response to Arguments

19. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection, as described above.

Conclusion

20. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-6,181,992	01-2001	Gurne et al.

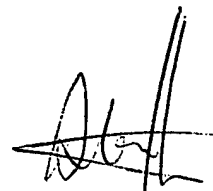
21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
August 2, 2005



STEPHEN HONG
SUPERVISORY PATENT EXAMINER